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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/000,062 | 11/02/2001 | Andrew Ishak | ISHAK-PA-1 | 9556 |

7590

05/29/2003

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EXAMINER

RAIZEN, DEBORAH A

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 05/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,062

Applicant(s)

ISHAK, ANDREW

Examiner

Deborah A. Raizen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action has two restriction requirements, as follows:

First Restriction Requirement

1. Restriction to one of the following inventions (numbered with Roman numerals) is required under 35 U.S.C. 121:

Ir1. Claims 1-23, drawn to an ophthalmic lens that has a dielectric mirror, classified in class 351, subclass 163.

IIr1. a) Claims 24-27, 29-31, 34-38 and 40, drawn to a lens that includes a rugate filter, classified in class 359, subclass 890 or class 351, subclass 44 and to an ophthalmic lens including a rugate filter, classified in class 351, subclass 44 or 163.

b) Claims 28, 32, 33, and 39, drawn to a lens that includes both a dielectric mirror and a rugate filter, classified in class 359, subclass 890 or class 351, subclass 44.

2. Inventions Ir1 and IIr1(a) are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Ir1 has separate utility such as a sunglass lens having the filtering properties shown in Fig. 2. See MPEP § 806.05(d).

3. Inventions Ir1 and IIr1(b) are related as subcombination and combination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not

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require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claims 28 and 39, for example, do not have the particulars of the dielectric mirror (such as those recited in claims 5 and 6) and other particulars of the lens having a dielectric mirror and no rugate filter. The subcombination has separate utility such as a sunglass lens having the filtering properties shown in Fig. 2.

4. Because these inventions are distinct for the reasons given above and the search required for Invention IIr1 is not required for Invention Ir1, restriction for examination purposes as indicated is proper.

Second Restriction Requirement

5. If Invention Ir1 of the first restriction requirement above was elected, restriction to one of the following inventions is required under 35 U.S.C. 121:

Ir1:Ir2. The part of Markush Claim 2 and its dependent claims 3, 4, and 7, and claims 9-16, drawn to an ophthalmic lens that is tinted with blue-blocking amber tint, classified in class 351, subclass 163.

Ir1:IIr2. The part of Markush Claim 2 and its dependent claims 3, 4, and 7, and claims 8, 17-23, drawn to an ophthalmic lens that is tinted with color-discriminating grey tint, classified in class 351, subclass 163.

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The rest of the claims of Invention Ir1 will be examined with either elected invention of this second restriction requirement.

6. The inventions are distinct, each from the other because of the following reasons:

Inventions Ir1:Ir2 and Ir1:IIr2 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions Ir1:Ir2 and Ir1:IIr2 (and the respective tints) are not disclosed or claimed to be usable together and give rise to different spectra, as shown in the figures (the spectrum of Ir1:Ir2 is shown in Fig. 4 and the spectrum of Ir1:IIr2 is shown in Fig. 2).

7. Claim 1 links inventions Ir1:Ir2 and Ir1:IIr2. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 1. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable.

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In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

8. If Invention IIr1 of the first restriction requirement above was elected, restriction to one of the following inventions is required under 35 U.S.C. 121:

IIr1:Ir2. The part of Markush claims 29 and 40, and claim 35, drawn to an ophthalmic lens that is tinted with blue-blocking amber tint, classified in class 351, subclass 163.

IIr1:IIr2. The part of Markush claims 29 and 40, and claim 34, drawn to an ophthalmic lens that is tinted with color-discriminating grey tint, classified in class 351, subclass 163.

The rest of the claims of Invention IIr1 will be examined with either elected invention of this second restriction requirement.

9. The inventions are distinct, each from the other because of the following reasons: Inventions IIr1:Ir2 and IIr1:IIr2 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions IIr1:Ir2 and IIr1:IIr2 (and the respective tints) are not disclosed or claimed to be usable together and would give rise to different spectra.

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10. Claims 24-26 and 38 link inventions IIr1:Ir2 and IIr1:IIr2. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 24-26 and 38. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Conclusion

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Raizen whose telephone number is (703) 305-7940. The examiner can normally be reached on Monday-Friday, from 8 a.m. to 4:30 p.m. EST.

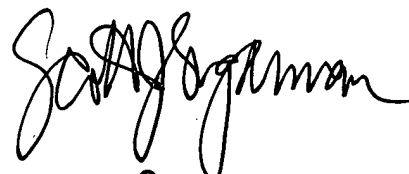
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (703) 308-4883. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

dar
May 21, 2003



Scott J. Sugarman
Primary Examiner